

REMARKS

Summary of the Office Action

Restriction to one of the following inventions is required under 35 U.S.C. § 121 for the reasons stated at page 2 of the Final Office Action: Group I (claims 9-17 and 27-35) and Group II (claims 18-26 and 36-44). Moreover, the Final Office Action states that since Applicants have already received an action on the merits for the originally presented invention, this invention (i.e., Group I) has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-26 and 36-44 have been withdrawn from consideration as being directed to a non-elected invention.

Claims 9-14, 17, 27-32 and 35 stand rejected under 35 U.S.C. §102(e) as being anticipated by the previously-applied Endoh et al. (U.S. Patent No. 6,016,295) (hereinafter “Endoh”). Claims 15-16 and 33-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Restriction Requirement

In the Final Office Action, the Examiner alleges that claims 18-26 and 36-44, which were newly-submitted in the Amendment filed on December 16, 2002, are directed to an invention that is independent or distinct from the invention originally claimed in this application. Accordingly, the Final Office Action states that restriction to one of the following inventions is required under 35 U.S.C. § 121 for the reasons stated at page 2 of the Final Office Action: Group I (claims 9-17 and 27-35) and Group II (claims 18-26 and 36-44).

Moreover, the Final Office Action states that since Applicants have already received an action on the merits for the originally presented invention, this invention (i.e., Group I) has been constructively elected by original presentation for prosecution on the merits. Accordingly,

claims 18-26 and 36-44 have been withdrawn from consideration as being directed to a non-elected invention. Applicants respectfully traverse this restriction requirement, and the Final Office Action's withdrawal of claims 18-26 and 36-44 from consideration is also traversed, for at least the following reasons.

The Final Office Action states at page 2, line 11 that the "inventions are distinct, each from the other because: Inventions I and II are related as subcombinations disclosed as usable together in a single combination." The Final Office Action then cites to MPEP § 806.05(d) in support of this restriction requirement. Applicants respectfully submit that MPEP § 806.05(d) states that "[t]wo or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other (emphasis added)." Applicants respectfully submit that while the combinations recited in each of independent claims 9 and 18, and also independent claims 27 and 36, are certainly "separately usable" from each other, MPEP § 806.05(d) also requires the alleged subcombinations to be "disclosed as usable together in a single combination," as indicated by the underlined portion of the MPEP quoted above. Applicants respectfully traverse the restriction requirement in that the respective combinations recited in each of independent claims 9 and 18, and also independent claims 27 and 36, are not intended to be "usable together in a single combination" in the manner required by MPEP § 806.05(d). Accordingly, it is respectfully submitted that this restriction requirement is clearly improper.

Further in this regard, MPEP § 803 states that the two criteria for a proper requirement for restriction between patentably distinct inventions are (1) the inventions must be independent or distinct as claimed, and (2) there must be a serious burden on the Examiner if restriction is not required. With regard to item (1), Applicants refer to the foregoing arguments regarding why the

restriction requirement does not comply with MPEP § 806.05(d). Moreover, with regard to item (2), Applicants respectfully submit that the Examiner has not shown that there would be a serious burden on the Examiner if a restriction was not required, especially since both independent claims 9 and 18, for example, are each directed to an “information reproducing apparatus” combination having similar features to each other.

Accordingly, withdrawal of the restriction requirement in the Final Office Action dated December 4, 2004 is respectfully requested. As a result, rejoinder of claims 18-26 and 36-44 is also respectfully requested.

Rejection under 35 U.S.C. § 102(e)

Claims 9-14, 17, 27-32 and 35 stand rejected under 35 U.S.C. §102(e) as being anticipated by the previously-applied Endoh et al. (U.S. Patent No. 6,016,295) (hereinafter “Endoh”). This rejection is respectfully traversed for at least the following reasons.

In the Amendment filed on December 16, 2002, Applicants explained that Endoh fails to disclose at least the claimed combination including “a reproducing device for reproducing the audio information in the recording method, which is selected by the selecting device from among the plurality of audio information same in content and different in recording method, on the basis of the control information and the record information read by the reading device,” as set forth in independent claim 9.

Applicants went on to explain that Endoh teaches an audio system for converting an audio data by a decoder into surround audio signals (emphasis added). See Abstract, lines 4-8, and column 10, lines 29-32 of Endoh. Applicants pointed out to the Examiner that no portion of

Endoh's disclosure appears to discuss reproducing the audio information among a plurality of audio information which are different in recording method.

Moreover, in the Supplemental Response filed on April 7, 2003, Applicants argued that Endoh also fails to teach or suggest at least the claimed combination recited in independent claim 27 including "the control information recorded on the control information recording area including identification information indicating that the plurality of audio information are same in content and different in recording method with each other, said information reproducing method for reproducing the audio information in accordance with the control information, comprising the steps of: ...selecting the recording method, the audio information in which is to be reproduced, on the basis of the designation information or set information stored in a memory device; and reproducing the audio information in the recording method, which is selected by the selecting step from among the plurality of audio information same in content and different in recording method, on the basis of the control information and the record information read by the step reading the record information."

In response, at page 3, section 5 of the Final Office Action, the Examiner alleges that Applicants' arguments "have been fully considered but they are not persuasive" because Endoh "discloses a system/method that records and reproduces audio using plural selectable encoding modes, i.e., the claimed 'different in recording method', as shown in figures 56 and 64-70."

Applicants respectfully traverse the rejection under 35 U.S.C. § 102(e) for at least the following reasons. In particular, the applied arrangements in Endoh are distinguishable from the arrangements and methodologies recited in independent claims 9 and 27, respectively, at least because the claims do not only recite that the "plurality of audio information" are "different in

recording method.” Instead, the claims go on to additionally recite that the “plurality of audio information” are the “same in content.”

The specification of the instant application explains that high density discs, such as DVD format discs, provide ample capacity to store multiple versions of the same content (for example, same song performance), but recorded in different formats (i.e., by different recording methods). As a result, the same song, for example, can be recorded on a disc in different formats (such as two-channel stereo format and multi-channel format). Both versions of the same song are stored within one title set. Accordingly, user confusion can be minimized by organizing both format versions of the same song performance within one title set. It is important to note that the “same content” limitations of the claims means that the overall recording is the same, despite being recorded in the different formats.

The portions of Endoh cited to in the Final Office Action, in particular Figs. 56 and 64-70, show and describe an audio system, used particularly in a karaoke environment, in which the different codings referred to by the Final Office Action do not represent the same overall recording. For example, col. 29, line 26 – col. 30, line 13 explains that mode 010 specifies a recording including an orchestra; mode 011 specifies a recording including an orchestra and a guide melody; mode 100 specifies a recording including an orchestra and vocal; mode 101 specifies a recording including orchestra, guide melody, and vocal; mode 110 specifies a recording including orchestra, female vocal and male vocal; while mode 111 specifies orchestra, guide melody, female vocal and male vocal.

Thus, each of these different encoding modes include different combinations of recorded information. In other words, the listener will hear different instruments or voices in some modes that are not heard in other modes. No two modes include the same overall recording.

Accordingly, these different modes do not include the “same content” as recited in at least independent claims 9 and 27 of the instant application. The arrangements and methodologies of the instant application involve storing multiple versions of the same content (i.e. same performance/overall recording of a song) with the versions differing from each other only in the format in which they are recorded, as discussed above and in the specification.

Moreover, the applied Figs. 64-70 of Endoh, and their corresponding description, relate to a “down-mixing” feature, in which by selecting the positions of various switches, the user is able to create a sound output that includes varying combinations of instruments and vocals, as discussed above with regard to modes 010, 011, 100, 101, 110 and 111.

As a result, the recorded information is not recorded in “different recording methods” as recited in the instant application’s claims and discussed in the instant application’s specification. Instead, the surround sound capabilities of Endoh’s arrangement are used to create different sound outputs (i.e., different instruments, male and/or female voices, and enabled or disabled guide melody) by selecting particular switch connections in Figs. 64-68 using Endoh’s disclosed “down-mixing” feature to obtain the desired output.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because Endoh does not teach or suggest each feature of independent claims 9 and 27. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Furthermore, Applicants respectfully assert that dependent claims 10-17 and 28-35 are allowable at least because of their dependence from independent claims 9 and 27, respectively,

and the reasons set forth above. Moreover, the Examiner is thanked for the indication that claims 15-16 and 33-34, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form. Withdrawal of the objection of claims 15-16 and 33-34 is respectfully requested at least for the reasons set forth above with regard to their respective base claims.

Finally, Applicants respectfully submit that withdrawn claims 18-26 and 36-44 should be rejoined into this application for at least the reasons set forth above with regard to Applicants' traversal of the restriction requirement. These withdrawn claims are in condition for allowance for similar reasons as those set forth above and also for the reasons set forth in the Supplemental Response filed on April 7, 2003 in this application.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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